

REMARKS

As a formal matter, the Office Action at page 2, lines 11-12 states that “[c]laims 1-7 and 16-17 are amended,” but at page 4, line 10 states that “no amendments were submitted.” Applicant respectfully requests that this discrepancy be corrected in the next Office Action for ensuring an accurate record.

The Office Action maintained the 35 U.S.C. § 103(a) rejection of claims 1-7 and 16-18 over WO 99/14335 to Porro et al. (“Porro”), as set forth in the prior Office Action mailed March 13, 2009. Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection for at least the following reasons.

The Office Action at page 5, lines 3-5 contends that Porro teaches that “integrative vectors can be obtained by using homologous DNA sequences in a certain regions of the host genome, allowing, by homologous recombination, integration of the vector,” referring to page 12, lines 12-15 of Porro. The Office Action at page 5, lines 6-8 further asserts that this type of integrative vector would lead a skilled artisan to produce the claimed microorganism, because Porro also disclosed other features of the claimed invention. The Office Action at page 10 cites a purported rationale for the conclusion of obviousness, i.e., that “all of the claimed elements were known in the prior art, that one skilled in the art could have combined the element as claimed by known methods with no change in their respective functions, and [that] the combination would have yielded predictable results to one of ordinary skill in the art [at the time of invention.]” M.P.E.P. § 2143(A).

To reject a claim based on a rationale of M.P.E.P. § 2143(A), however, the Office must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966), may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

At best, the arguments in the Office Action may have some relation to the findings (1) and (2) of M.P.E.P. § 2143(A), but, they do not support either finding (3) or finding (4) of § 2143(A).

Moreover, Porro teaches production rates of only lactic acid from lactate dehydrogenase carried on numerous copies of plasmids (Tables B on page 52; Table 6 on 61). One of ordinary skill in the art would not have predicted the results of the alleged combination, as being similar to the results of the claimed transformants, because one of ordinary skill in the art, relying on Porro's teaching, would not have recognized the increased efficiency of lactic acid production from using integrative vectors in which a single copy of lactate dehydrogenase gene is carried (as explained in the previous Reply to Office Action filed June 15, 2009). Hence, one of ordinary skill in the art would not have recognized any predictability of the results of the proposed

combination of features, and the Office Action has not satisfied the criteria of M.P.E.P. § 2143(A)(3).

For at least the above reasons, the 35 U.S.C. § 103(a) rejection of claims 1-7 and 16-18 over Porro is improper and claims 1-7 and 16-18 are allowable over Porro.

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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